

REMARKS/ARGUMENTS

Claims 1-8 are pending in the present application.

The specification has been objected to for the informality of characterizing notch 28 as an "irregular cross section area" based on the belief of one of ordinary geometric skill that a tapered surface is a regular shape. In response, the Applicant has added the wording "that tapers inwardly to a point" after the word "notch" (page 2, lines 3, 7, 21, 23, and 30); after the word "area" (page 4, line 11); after the numeral "28" (page 5, line 21) and after the word "notch" (page 5, lines 24 and 29).

Rejections under 35 U.S.C. § 112

Claims 1-8 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient." In re Wertheim, 541 F.2d 257, 265, 191 U.S.P.Q. 90 (CCPA 1976). Claims of a patent application are to be construed in the light of the specification and the understanding of those skilled in that art to whom they are addressed. In re Myers, 56 CCPA 1129, 1135, 410 F.2d 420, 425, 161 USPQ 668, 672 (1969).

In response, the Applicant has amended independent claims 1, 4, and 5, to require that the notch taper inwardly to a point. Applicant believes this overcomes the rejection.

Claim 1 stands rejected as not being supported by the specification, because the Examiner has determined that the specification does not mention the notch as being variable. In

response, the Applicant has removed the word "variable" preceding the phrase "irregularly shaped metered porting notch" (claim 1, lines 4-5). Further, claim 1 stands rejected for clarity for the phrase "irregularly shaped metered porting notch" where the Examiner has determined it is unclear what shapes would be irregular and what shapes are not irregular. In response, the Applicant has added the wording "that tapers inwardly to a point" after the word "notch" (claim 1, line 7).

Claim 4, line 5 and claim 5, line 4 are rejected for the reason discussed above. In response, the Applicant has added the wording "that tapers inwardly to a point" after the word "port" (claim 4, line 5; and claim 5, line 4).

Claim 1 lines 5-6 are rejected where the Examiner determined that a drain as part of the piston is confusing. In response, the Applicant has removed the phrase "of the piston" from claim 1 and has amended the wording of claim 4 to read "servo piston drain."

Claim 4 stands rejected for being incomplete where the Examiner determined that the claim ends with a semicolon, not a period. In response, the Applicant has added the limitation "a sleeve surrounding the spool such that the spool is partially disposed within and adapted to respond to an error signal generated by the spool." to follow after the semicolon.

Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by Roeske. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom

Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

In response, the Applicant has amended claim 1 line 14 to read "metering porting notch that tapers inwardly to a point." Similarly amended claims 4 and 5 require, in part, "an irregularly shaped servo drain metering port that tapers inwardly to a point." As shown in Fig. 3 and supported by the specification (page 4, lines 12-15), the notch servo drain (Fig. 3, Ref. No. 28) tapers inwardly to a point (Fig. 3, Ref No. 30). In contrast, Koeke discloses a round cross section of the "pressure exhaust passage" drain port (Figs. 3 and 4, Ref. No. 146; see also col. 3, lines 44-47). Therefore, Koeke does not disclose each and every element required in claims 1, 4, and 5,

and the Applicant respectfully requests that the rejection be withdrawn. Furthermore, claims 2, 3, 6, 7, and 8 depend on the limitations of claims 1 and 5 and overcome the anticipation rejection for that reason.

The Examiner has rejected claim 4 under 35 U.S.C. § 102(b) as being anticipated by Morin et al. Claim 4 requires, in part, an irregularly shaped servo drain metering port that tapers inwardly to a point (pages 4, lines 12-15; see also Fig. 3, Ref. Nos 28. and 30). In contrast, the Morin et al. patent discloses a rotary spool valve where the "servo drain metering port" is circular and does not taper inwardly to a point (Morin et al., col. 2, lines 32-25; see also Figs. 3 and 4, Ref. Nos. 37 and 40). Therefore, Morin et al. does not disclose each and every element required in claim 4, and the Applicant respectfully requests that the rejection be withdrawn.

The Examiner has rejected claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by Forster. As previously mentioned claims 1, 4, and 5 have been amended with the limitation, "that tapers inwardly to a point." In contrast, the Forster patent discloses round servo drain metering ports that do not taper to a point (Forster, col. 4, lines 49-59; see also Fig. 3, Ref. Nos. 60 and 61). Therefore, Forster does not disclose each and every element required in claims 1, 4, and 5, and the Applicant respectfully requests that the rejection be withdrawn. Furthermore, claims 2, 3, 6, 7, and 8 depend on the limitations of claims 1 and 5 and overcome the anticipation rejection for that reason.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-8 as being obvious under 35 U.S.C. § 103(a) over Forster in view of the inherent closed

circuit characteristic of hydrostatic systems. The proposed apparatus that results still would not have all the elements of independent claims 1, 4, and 5, as amended, of the invention. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Independent claims 1, 4, and 5 have been amended with the limitation, "that tapers inwardly to a point," as discussed above. Forster discloses round servo drain metering ports that do not taper to a point (Forster, col. 4, lines 49-59; see also Fig. 3, Ref. Nos. 60 and 61). Therefore, Forster in view of inherent hydrostatic characteristics does not disclose each and every element required in claims 1, 4, and 5, and the Applicant respectfully requests that the rejection be withdrawn. Furthermore, claims 2, 3, 6, 7, and 8 depend on the limitations of claims 1 and 5 and overcome the anticipation rejection for that reason.

CONCLUSION

In view of the above remarks and arguments, Applicant believes that claims 1-8 are in condition for allowance and Applicant respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley
Reg. No. 45,253
ZARLEY LAW FIRM, P.L.C
Capital Square
400 Locust Street, Suite 200
Des Moines, IA 50309-2350
Phone No. (515) 558-0200
Fax No. (515) 558-7790
Customer No. 34082
Attorneys of Record

- JLH/BPT/jlk -